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### REMARKS

This paper is responsive to the non-final Office Action mailed January 26, 2005.

Claims 1-25 were pending in this patent application. Claims 1-8, 10, 11 and 14-25 have been rejected, claims 9, 12, and 13 have been objected to. Claims 1, 9-15, and 20 have been amended, claims 8, 18, and 23 have been cancelled and claims 26-27 have been added. Upon entry of this paper, claims 1-7, 9-17, 19-22, and 24-27 will remain pending in this application.

No new matter has been added by this amendment. Support for the amendments includes at least paragraphs [0035] – [0043] in the application as published.

### Specification

The Examiner objected to the disclosure and required that the information relating to the co-pending application be updated. The specification has been amended to include the updated information.

### Claim Rejections - 35 U.S.C. § 112

Claims 8, 18, 23, and 24 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter claimed therein. The Examiner argued that the term “a state” causes the claims to be vague and indefinite. Applicants have canceled claims 8, 18, and 23 without prejudice. However, the phrase “a state” has been incorporated into independent claims 1, 15, and 20 and remains in pending claim 24.

The support for the term “a state” in reference to the fireplace is detailed in Applicants’ disclosure:

The control system 320 can control the operation of light source 305, 310, and 315 of the backlighting system 300. One method of control includes turning the light source on and off in response to a state of the fireplace. For example, if the control system 320 senses that the fireplace is no longer simulating a fire within the combustion chamber (i.e., an off state), it can then turn the light sources 305, 310, and 315 of the backlighting system 300 on to generate backlighting. Similarly, if the control system 320 senses that the fireplace 100 is simulating a fire within the combustion chamber 110 (i.e., an on state), it can then turn the light sources 305, 310, and 315 off. In some embodiments, it may be desired to continue to generate backlighting when the fireplace 100 is simulating a fire within the combustion chamber 110, or to

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synchronize flame modulation with backlighting modulation.” (page 6, line 28 through page 7, line 6)

Optionally, control system 320 can be utilized to modulate the light generated at the light sources 305, 310, and 315. This modulation can occur in response to a condition or state of the fireplace or be a programmed modulation. For example, the control system can be configured control each of the individual light sources 305, 310, and 315 to varying the intensity of the individual light sources 305, 310, and 315 in a pattern.

Paragraphs [0037] – [0038] (emphasis Added). As illustrated, the “off state” of the fireplace is defined as the condition at which the “fireplace is no longer simulating a fire.” Likewise, the “on state” is defined as the condition at which the “fireplace 100 is simulating a fire.” The phrase “a state” therefore generally refers to a fireplace condition including at least an on and off state. Additionally, the control system can further modify the light based upon a fireplace condition by modulating “the light generated at the light source in response to a condition or state of the fireplace.” Paragraph [0038]. One example of such a modulation may include synchronizing the backlighting modulation with flame modulation.

In view thereof, Applicants respectfully submit that the term “a state” as related to the operation of the fireplace is well defined in the original disclosure and, as such, is not vague and indefinite. The claimed invention would be apparent to one skilled in the art.

#### **Claim Rejections - 35 U.S.C. § 102 and 103**

In rejecting the claims under 35 U.S.C. § 102(b) and 103, the Examiner states that the recitation “a combustion chamber” (claims 1 and 20) is a recitation of intended use. Applicants respectfully disagree with this interpretation. To one skilled in the art the recitation “a combustion chamber” implies a structure in a fireplace for containing combustion or containing heat generating element such as is used in an electric fireplace.

Applicants’ disclosure defines the structure of the combustion chamber of the present invention, in one example, as “a top panel 80, a bottom panel 82, and a continuous side panel 84 that extends around the sides and rear portion of the combustion chamber enclosure 14 forming a vertical back wall thereof.” Paragraph [0054]. Page 11, lines 19-22 and line 25. In addition, the specification describes the different types of fireplaces that can include a combustion chamber as described and claimed, such as “any prefabricated gas fireplace, such as a direct vent, a universal vent, a B-vent, a horizontal/vertical-vent, a dual direct vent, or a multisided unit” in addition to “any other fireplace

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that generates heat, such as a simulated electric fireplace or solid fuel burning fireplace.” Paragraph [0031]. Thus, the recitation “a combustion chamber” includes definitive structure and not a recitation of intended use.

### Claim Rejections - 35 U.S.C. § 102

#### Independent Claim 1 is not Anticipated by *Steingruber*

Claims 1-4, 6, 8, 11, and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 2,445,250 to Steingruber (“*Steingruber*”). *Steingruber*, however, does not teach, disclose, or suggest all of the recited elements of independent claim 1. Claim 1 also does not read upon *Steingruber* and therefore *Steingruber* does not anticipate the subject matter claimed by independent claim 1.

Claim 1 recites a limitation directed to “a control system positioned in the fireplace and operably connected to the backlighting system” and “a sensor positioned in the combustion chamber and operably coupled to the control system, wherein the sensor senses a state of the fireplace and the control system controls the backlighting system depending on the state of the fireplace.” Independent claim 1 therefore recites a sensor that senses the state of the fireplace and a control system that, utilizing input from the sensor, controls the backlighting system.

*Steingruber* teaches a portable space heater with a heating element and an electric lamp mounted adjacent to the back lower panel. The lamp 64 is connected in parallel with the main power switch that controls the heating element. In *Steingruber* the on and off status of the backlighting system is linked to the operating state of the heating element such that the light is on when the heating element is on and the light is off when the heating element is off. There is no sensor that senses the state of the fireplace and furthermore no control system that controls the backlighting system based upon the state of the fireplace. Every element of amended claim 1 is therefore not taught by *Steingruber* and *Steingruber* does not read independent claim 1. Claim 1 is therefore allowable over *Steingruber*.

In addition, claims 2-4, 6, 8, 11, and 14 depend directly or indirectly from independent claim 1 and are therefore also allowable for at least these same reasons.

#### Independent Claims 1, 15, and 20 are not Anticipated by *Morley*

Claims 1-4, 8, 10, 11, 14-17, 19-22, and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by British Patent Number 2261942 to Morley et al. (“*Morley*”). *Morley* does not,

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however, teach, suggest, or disclose all of the limitations of amended claims 1, 15, and 20. Claims 1, 15, and 20 also do not read upon the disclosure in *Morley*. Claims 1, 15, and 20 are therefore allowable.

Claims 1 and 15 recite a limitation directed to “to “a control system positioned in the fireplace and operably connected to the backlighting system” and “a sensor positioned in the combustion chamber and operably coupled to the control system, wherein the sensor senses a state of the fireplace and the control system controls the backlighting system depending on the state of the fireplace.” Furthermore, claim 20 requires:

- placing a sensor in the combustion chamber and connecting the sensor to a control system;
- sensing a state of the fireplace with the control system; and
- controlling the backlighting system depending on the state of the fireplace whereby the backlighting system shines light from the light source onto the back panel of the enclosure.

Each of the independent claims of the present application therefore recite a sensor that senses the state of the fireplace and a control system wherein the control system utilizes input from the sensor, controls the backlighting system.

*Morley* discloses a “live fuel assembly for a gas-fired heating appliance” that includes “rear light units 10 and 11.” The lighting units 10 and 11 include a light bulb with a reflector. *Morley* neither teaches, discloses, nor suggests a sensor that senses a state of the fire or a control system operably attached to the sensor wherein the control system controls the light bulbs in response to the state of the fire. Claims 1, 15, and 20 do not read upon *Morley* and *Morley* does not anticipate claims 1, 15, or 20.

In addition, claims 2-4, 8, 10, 11, 14, 16-17, 19, 21-22 and 25 depend directly or indirectly from one of independent claims 1, 15, and 20. Claims 2-4, 8, 10, 11, 14, 16-17, 19, 21-22 and 25 are therefore also allowable for at least these same reasons.

#### Claim Rejections - 35 U.S.C. § 103

Claims 5, 6, 7, and 10 were rejected under 35 U.S.C. § 103(a) as being obvious over *Morley* or *Steingruber*. Claims 5, 6, 7, and 10, however, are directly or indirectly dependent upon independent claim 1 and therefore incorporate all of the recited elements of claim 1. Since claim 1 is

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allowable over *Stengruber* and *Morley*, claims 5, 6, 7, and 10 are allowable for at least these same reasons.

Reconsideration and withdrawal of these rejections is respectfully requested.

#### **Allowable Subject Matter**

Claims 9, 12, and 13 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicants would like to thank the Examiner for his helpful comments regarding claims 9, 12, and 13.

In view of the Examiner's statements, claim 9 was rewritten in independent form to incorporate all of the limitations of claim 1. New claims 26 and 27, which incorporate the limitations of claims 12 and 13, were also added and depend from claim 9. Applicants believe that claims 9 and 26-27 are therefore allowable.

#### **PETITION FOR EXTENSION OF TIME**

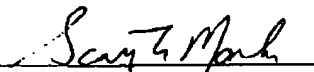
The Applicant herewith petitions the Commissioner to extend the time for reply to the Office Action dated January 26, 2006 for one (1) month, from April 26, 2006, to May 26, 2006. A credit card payment form in the amount of \$120.00 for a one-month extension of time is submitted herewith. Also enclosed is a credit card payment in the amount of \$200.00 for 1 extra independent claim. No additional fee is believed to be necessary for the entry of this paper. Should any additional fee be required for entry of this paper, the Commissioner is authorized to charge the Faegre & Benson Deposit Account No. 06-0029 and in such event, is requested to notify us of the same.

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### CONCLUSION

Upon entry of this paper, claims 1-7, 9-17, 19-22, and 24-27 are pending in the present patent application. These pending claims are believed to be in condition for allowance. Reconsideration and prompt passage of the application to allowance is respectfully solicited.

Respectfully Submitted,  
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